

Remarks

The Supplemental Office Action dated May 12, 2009 has been carefully considered. Reconsideration of the current claims in view of the following remarks is respectfully requested.

Information Disclosure Statement

The Attorney for Applicant acknowledges paragraph 1 of the Office Action and the status of the Information Disclosure Statement filed 08/24/06, and that this IDS has been placed in the file, but has not been considered. Abeyance is requested on this matter until a concise explanation can be provided.

Claim Rejections – 35 USC § 103

In Paragraph 4 of the Office Action, claims 1-6, 8, 14-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (US 3,875,069) (referred to as ‘069) in view of Worschech et al. (4,637,887) (referred to as ‘887).

The ‘069 and ‘887 references have been considered in view of the factual inquiries set forth in *Graham v. John Deere Co.*, and, in particular, the following is a summary of the scope and content of the ‘069 and ‘887 references, and the differences between the ‘069 and ‘887 references and the claims at issue.

The present invention is directed to lubricant combinations for thermoplastics comprising a) natural fats and oils with iodine values below 10, and b) standard lubricants for thermoplastics which are different from a).

The '069 patent discloses a lubricant composition for shaping thermoplastics wherein the lubricant composition includes (A) mixed esters and (B) esters selected from the group consisting of (1) esters of phthalic acid and alkanols of 12 to 30 carbon atoms and (2) partial esters of glycerin and aliphatic hydrocarbon monocarboxylic acids having 12 to 30 carbon atoms and mixtures of partial esters of glycerin and hydroxyalkanoic acids having 12 to 30 carbon atoms and triglycerides of hydroxyalkanoic acids having 12 to 30 carbon atoms, with a ratio of (A) to (B) being 1:3 to 9:1.

According to column 5, line 35 of the '069 patent, component A is obtained from starting materials, which may also comprise "mixtures of fatty acid fractions of 12 to 30 carbon atoms which are obtainable from natural fats and oils, etc." (Col 6, lines 21 to 25). Hence, component A of the '069 patent is not a natural fat or oil any more but a conversion product or derivative of such a natural fat or oil.

Moreover, the '069 patent teaches away from the present invention. As set forth in the Office Action, the '069 patent does not disclose an iodine number below 10 or below 8, or between 0.1 and 5. The only quotation of an iodine number in the '069 patent was found in column 6, line 58, in which compounds having an iodine number 50 are disclosed. However, we could not find any suggestion in the '069 patent that assigns an affect to the iodine number, nor any indication to select compounds of a specific preferred range of iodine numbers. There is no disclosure in the '069 patent that would lead one skilled in the art to consider the iodine value. Furthermore, it appears that one skilled in the art seeking a lubricant wherein aromatic phthalates (esters of phthalic acid) are to be avoided, would disregard the '069 patent, since the lubricant composition of the '069 patent comprises the esters of phthalic acid and alcohols according to claim 1 of the '069 patent.

The '887 patent discloses a lubricant composition comprising a “...*molding lubricant consisting essentially of triglycerides containing hydroxyl fatty acid residues obtained by hydrogenating at least one epoxidized natural fat or oil selected from...*” (claim 1). According to the '887 patent, the triglycerides containing hydroxy fatty acid residues are obtained by a chemical reaction from natural fats and oils as starting materials (col 1, line 65 ff.). These natural fats and oils are first epoxidized (col 2, line 3), and subsequently hydrogenated (col 2, lines 9-19).

In conclusion, the triglycerides of the '887 patent are not natural fats and oils, as set forth in the present claims. Moreover, the '887 patent teaches away from the present claims. According to column 1, lines 51-52, the triglycerides of the '887 patent “may be used as a substitute for hardened castor oil.” However, the natural fats and oils of the present invention are employed as a substitute for esters of phthalic acid (example C, B3, and B5 of the present application, page 13). Hence, the '887 patent discloses substituting another type of compound in a lubricant composition. Based on the foregoing factual inquiries, the rejection of claims 1-6, 8, 14-18, and 20 under 35 U.S.C. 103(a) as being unpatentable over the '069 patent in view of the '887 patent has been rebutted, and it is respectfully requested that this rejection be withdrawn.

In Paragraph 5 of the Office Action, claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (US 3,875,069) (referred to as '069) in view of Worschech et al. (4,637,887) (referred to as '887) as applied to claims 1-6, 8, 14-18, and 20 above, and further in view of Haack et al. (US 5,889,102). Haack et al. discloses that pentaerythritol tetrastearate is a known lubricant for use in combination with other lubricants for use with plastics. However, combining this fact with the '069 and '887 patents fails to disclose the present invention set forth in the current claims as set forth in the foregoing remarks for the rejection of claim 9. Based on

the foregoing factual inquiries, the rejection of claim 9 under 35 U.S.C. 103(a) as being unpatentable over the '069 patent in view of the '887 patent in view of Haack et al. has been rebutted, and it is respectfully requested that this rejection be withdrawn.

In Paragraph 6 of the Office Action, claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (US 3,875,069) (referred to as '069) in view of Worschech et al. (4,637,887) (referred to as '887) as applied to claims 1-6, 8, 14-18, and 20 above, and further in view of Dohi et al. (US 2004/0014861A).

Dohi et al. discloses a material useful in the molding of polycarbonate material which uses dipentaerythritol hexastearate. However, combining this fact with the '069 and '887 patents fails to disclose the present invention set forth in the current claims as set forth in the foregoing remarks for the rejection of claim 10. Based on the foregoing factual inquiries, the rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over the '069 patent in view of the '887 patent in view of Dohi et al. has been rebutted, and it is respectfully requested that this rejection be withdrawn.

In Paragraph 7 of the Office Action, claims 7 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (US 3,875,069) (referred to as '069) in view of Worschech et al. (4,637,887) (referred to as '887) as applied to claims 1 and 6 above, in view of Dohi et al. (US 2004/0014861A) as applied to Claim 10, in view of Haack et al. as applied to Claim 9, and further in view of Lindner (US 6,818,689).

Lindner discloses a lubricant composition for use in the processing of polyvinyl chloride comprising an ester of a monofunctional organic acid and a monohydric alcohol wherein the ester is stearyl stearate. However, combining the disclosures of the '069 and '887 patents fail to disclose the present invention as set forth in the current claims, which has been previously

discussed in the remarks for the rejection of claims 1-6 on pages 2-4 above. Based on the foregoing factual inquiries, the rejection of claims 7 and 11-13 under 35 U.S.C. 103(a) as being unpatentable over the '069 patent in view of the '887 patent in view of Dohi et al. in view of Haack et al., and further in view of Lindner has been rebutted, and it is respectfully requested that this rejection be withdrawn.

Conclusion

In view of the remarks presented herein, Applicant submits that the present application is in condition for allowance, and such action is respectfully requested. If, however, any issues remain unresolved, the Examiner is invited to telephone Applicant's counsel at the number provided below.

Respectfully submitted,

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